

REMARKS**I. Claim Objections**

The Examiner objected to claims 3-5, 10-11 and 19 because of the following informalities:

The Examiner argued that there is an extra semicolon after the term "indices" (citing line of claim 10) that needs to be removed.

The Examiner also asserted that there is insufficient antecedent basis for the following recitation:

In claim 3, line 5: "said plurality of marks"

In claim 4, line 6: "said plurality of locations"

In claim 5, lines 6-7: "said plurality of marks"

In claim 10, lines 2 and 12: "said at least one mark"

lines 5 and 8: "said multiple-device printing environment"

line 7: "said plurality of printers"

line 5: "said multiple-device printing environment"

line 10: "said at least one printer"

lines 13, 14, and 15: "said at least one mark"

In claim 11, line 5: "said linker"

The Examiner additionally indicated that a missing phrase needs to be inserted between the language "The system of claim 11" and "module places at least one mark" in line 1 of claim 19.

The Applicant has amended the above-referenced claims as indicated herein to correct the above-referenced deficiencies. The Applicant therefore submits that the claims as amended now overcome the foregoing objections. The Applicant respectfully requests that the foregoing objections to claims 3-5, 10-11 and 19 be withdrawn.

II. Claim Rejections – 35 U.S.C. § 112

The Examiner rejected claim 11 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which Applicant regards as the invention. The Examiner argued that the recitation "said linker thereafter automatically and dynamically rends at least one mark upon said print job" is inferentially recited.

The Applicant has amended claim 11 as indicated herein to correct the above-referenced deficiencies. The Applicant therefore submits that claim 11 as amended now overcomes the aforementioned rejections under 35 U.S.C. 112. The Applicant respectfully requests that the rejection to claim 11 be withdrawn.

III. Claim Rejections – 35 U.S.C. § 102***Requirements for Prima Facie Anticipation***

A general definition of *prima facie* unpatentability is provided at 37 C.F.R. §1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), adopted, 149 USPQ 640 (Ct. Cl. 1966)), cert. denied, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, Kurita must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic &*

Research Foundation v. Genentech, Inc., 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicant need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

Leong et al.

The Examiner rejected claim 1 under 35 U.S.C. 102(e) as being anticipated by Leong et al. (U.S. Patent No. 6,687,018).

With respect to claim 1, the Examiner argued that Leong et al teaches a method for distributing print jobs comprising identifying at least one printer among a plurality of printers in a multiple-device printing environment for rendering a print job (citing col. 6); and automatically and dynamically rendering at least one mark upon said print job based on a required resource of the at least one printer among the plurality of printers within the multiple device printing environment during an imposition of the print job (cols. 7-8).

The Applicant respectfully disagrees with this assessment. Applicant's amended claim 1 is directed toward a method, comprising:

establishing a database comprising a plurality of marks;

associating said database with a multiple-device printing environment;

identifying at least one printer among a plurality of printers in said a multiple-device printing environment for rendering a print job; and

automatically and dynamically rendering at least one mark among said plurality of marks upon said print job based on a required resource of said at least one printer among said plurality of printers within said multiple device printing environment during an imposition of said print job.

Applicant notes that Leong et al fails to disclose all of the claim limitations of Applicant's claim 1, including the the steps of establishing a database comprising a plurality of marks; and associating the database with a multiple-device printing environment. As such, this demonstrates that the Leong et al fails reference cited by the Examiner fails to disclose every element in Applicant's claim 1. Thus, the rejection to claim 1 under 35 U.S.C. 102 is now traversed. The Applicant therefore respectfully requests that the rejection to claim 1 under 35 U.S.C. 102 as being anticipated by Leong et al be withdrawn, because Leong et al does not disclose each and every claim limitation of Applicant's claim 1.

Given that Applicant' claim 1 is now allowable, the Applicant submits that any claims dependent upon claim 1 should also be allowable. The Applicant therefore respectfully requests that claims 2-9 be allowed, because claims 2-9 are dependent upon a claim (i.e., claim 1) that is allowable.

IV. Allowable Subject Matter

The Examiner objected to claims 2-9 as being dependent upon a rejected base claim, but indicated that such claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicant submits that claim 1 as now amended is allowable and that therefore dependent claims 2-9 should also be allowed in their present form because they are now dependent upon an allowable claim (i.e., claim 1).

The Examiner also allowed claims 1-20. The reasoning for such an allowance is indicated in the Office Action dated June 30, 2005.

V. Conclusion

The Applicant has amended the claims to more particularly disclose the invention claimed thereof. It is believed that such amendments do not constitute new matter, but are rather clarifying in nature. Additionally, it is believed that support for such amendments is provided within the specification, including the drawings, and that the specification adequately enables such amendments. In view

of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action, and respectfully request that a timely Notice of Allowance be issued.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call the Applicant's attorney at the below-indicated telephone number.

Respectfully submitted,



Kermit Lopez
Attorney for Applicant
Attorney Registration No. 41,953
Telephone: (505) 314-1312
E-mail: klopez@olpatentlaw.com

Dated: September 27, 2005

Page 11 of 11
Serial No. 10/758,508